

**REMARKS**

Claims 1-12 are pending in this application. For purposes of expedition, claims 1-12 have been amended in several particulars for purposes of clarity and brevity that are unrelated to patentability and prior art rejections in accordance with current Office policy, to further and alternatively define Applicants' disclosed invention and to assist the Examiner to expedite compact prosecution of the instant application.

Claim 1 has been rejected under 35 U.S.C. §102(b) as being anticipated by Hirayama et al., U.S. Patent No. 5,652,824. In support of this rejection, the Examiner asserts that Hirayama '824 discloses,

"a method of selecting audio channels of an A/V data stream comprising a plurality of programs (such as plurality of data bits), each program (such as a movie) comprising at least two kinds of audio data streams (e.g., Japanese and English), each audio data stream comprising at least two sub-audio data streams which are not repeated and have a series of channel IDs according to a predetermined order of precedence, the method comprising (see col.2 line 11-20):

(a) when one of the programs (see fig. 7, (S5)) is changed to another one of the programs, searching whether there is a sub-audio data stream having a channel ID which is the same as a user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before (such as (S10)) the program was changed, in the another program (see col. 11 line 12-67); and when it is determined (S8) that there is the sub-audio data stream having a channel ID which is the same as the user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before (S10) the program was changed, selecting the sub-audio data stream having the same channel ID of the another program (see fig. 7 line 12-67)."

However, the Examiner's assertion is factually incorrect. As a result, the rejection is respectfully traversed for reasons discussed herein below.

First of all, Hirayama '824 does **not** disclose what the Examiner alleges. Rather, Hirayama '824 discloses a multi-lingual recording medium, as shown in FIGs. 3A-3B, for recording information such as movie programs, educational programs and learning programs in various languages, such as English, Japanese, French and German, as shown, for example, in FIGs. 4A-4C. A management table is provided for creating a menu screen that enables a user to acknowledge a plurality of languages, as shown in FIGs. 5A-5B. In addition, a reproduction apparatus, as shown in FIG. 1, is provided to enable a user to select and decode speech and subtitles (characters) in a given language. As shown in FIG. 3B, the information (data unit)

recorded in a data area on the optical recording medium (i.e., disk) includes a sub-code followed by a sub-picture, audio information and video information. The audio information is recorded up to 8 different languages. The video information is recorded by high-efficient coding image compression techniques.

However, the audio information of Hirayama '824 does **not** correspond, and cannot be interpreted to read on Applicants' claimed "audio data stream comprising at least two sub-audio data streams which are not repeated and have a series of **channel IDs** according to a predetermined order of precedence" as defined in base claim 1. In fact, **no** where in Hirayama '824 is there any disclosure of any "sub-audio data stream having a channel ID."

The cited column 2, lines 11-20 of Hirayama '824 only refers to a data area on a disk, as shown in FIG. 3A, for storing data units in which each data unit contains video information and pieces of audio information including at least three pieces of language information, such as English, Japanese and French, related to the video Hirayama '824. Again, the cited portion of Hirayama '824 does **not** disclose Applicants' claimed "audio data stream comprising at least two sub-audio data streams which are not repeated and have a series of **channel IDs** according to a predetermined order of precedence" as defined in base claim 1.

Likewise, the cited FIG. 7 of Hirayama '824 only illustrates an operation of a reproduction apparatus, when an optical disk containing a movie is installed at S2. A first menu is displayed at S4, so that a user can select a main speech (for example, in English) for the movie. A second menu is then displayed at S6, so that a user can select a subtitle (for example, in Japanese) at S7. None of the steps shown in FIG. 7 of Hirayama '824 discloses or suggests any changing between programs, where a search is made with respect to whether "there is a sub-audio data stream having a channel ID which is the same as a user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed, in the another program" as defined in Applicants' base claim 1.

Moreover, no where in Hirayama '824 is there any disclosure of any channel selection between a first program to a second program, and, as a result, no disclosure of any search made when switching from a first to a second program and that a channel is selected based on the search finding a matching channel between the first and second programs as defined in Applicants' base claim 1.

The rule under 35 U.S.C. §102 is well settled that anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. In re

Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Those elements must either be inherent or disclosed expressly and must be arranged as in the claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); Verdegall Bros., Inc. v. Union Oil Co., 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987). In addition, the prior art reference must be enabling. Akzo N.V. v. U.S. International Trade Commission, 808 F.2d 1471, 1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). The corollary of that rule is that absence from the reference of any claimed element negates anticipation. Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ2d 81 (Fed. Cir. 1986).

The burden of establishing a basis for denying patentability of a claimed invention rests upon the Examiner. The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitations, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971).

In the present situation, Hirayama '824 fails to disclose and suggest key features of Applicants' base claim 1. Therefore, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2, and 4-12 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hirayama et al , U.S. Patent No. 5,652,824, as modified to incorporate selected features from Endoh et al., U.S. Patent No. 6,016,295. In support of the rejection of claims 2 and 4-12, the Examiner further cites Endoh '295, as a secondary reference, in FIG. 57, FIG. 59, and col. 32, line 42 - col. 33 line 52 for allegedly disclosing the feature of:

"when there is no sub-audio data stream having a channel ID which is the same as the channel ID assigned to the sub-audio data stream of the program which was being reproduced before being changed, the method in the another program further comprising selecting a sub-audio data stream having a channel selection number which has first precedence in the predetermined order of precedence among the sub-audio data streams of the another program (the previous audio channel ID can be interpret [sic] as the default language code and next program will continue to use the default code if it is the same, otherwise it

will change, and see figs. 57,59 and col.32 line 42-col.23 line 52)"

However, the Examiner's factually assertion is also incorrect. Endoh '295 does **not** disclose what the Examiner alleges, and certainly, does **not** remedy the noted deficiencies of Hirayama '824 in order to arrive at Applicants' claim 2. This is because Endoh '295 only discloses a karaoke reproduction machine which determines the surround mode and special use mode of the audio stream. (See Endoh Abstract). However, Endoh '295, like Hirayama '824, does not teach or suggest any connection between separate programs.

The cited FIG. 57 of Endoh '295 simply illustrates a retrieving operation of a video manager menu as displayed on the karaoke reproduction machine. FIG. 59 simply illustrates a retrieving operation of a video title set menu. The cited column 32, line 42 extending to column 33, line 52 of Endoh '295 refers to the selection of a language code in the video title set menu. In other words, Endoh '295 is simply matching a language code of the disc with the default setting of the reproducing apparatus (i.e., the karaoke machine). (See Endoh col.32, lines 53-58).

Nevertheless, the Examiner relies on a comparison that Endoh '295 performs with a default language code setting of the reproducing apparatus as being the previous channel ID of the previous program. The Examiner's reliance is misplaced. Endoh '295 does not disclose or suggest any user selection of a channel ID of the first or previous program and that the channel ID of the second program is selected based on a search for a channel ID that matches the user selected channel of the first program. As previously discussed, Endoh '295 is simply matching a language code of the disc with the default setting of the reproducing apparatus (i.e., the karaoke machine). (See Endoh col.32, lines 53-58).

As commonly understood, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art..."[the Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992). In addition, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Id. at 1783-84.

There is no teaching or suggestion in either Hirayama '824 or Endoh '295 to make any combination of the references. Hirayama '824 simply discloses a multi-lingual recording medium for recording information such as movie programs, educational programs and learning programs in various languages, such as English, Japanese, French and German, as shown, for example, in FIGs. 4A-4C. As a secondary reference, Endoh '295 searches a program that is recorded in more than one language for a match to a default of the reproducing machine. To set forth a *prima facie* §103 rejection, there must be some evidenced reason for modifying a reference. Specifically, there must be evidence, outside of the present application, which motivates, leads, or suggests to one of ordinary skill to modify a reference. In addition, an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966). However, in the instant case, no such evidence has been presented.

Moreover, even assuming *arguendo* that Endoh '295 can be incorporated into Hirayama '824, the Examiner's proposed incorporation still does not arrive at Applicants' claim 2. There is no teaching or suggestion in either of the cited references that changing from one program to another causes a search for a matching channel ID and selection of the matching channel ID as recited in each of the independent claims. (See for example, **"when one of the programs is changed to another one of the programs, searching whether there is a sub-audio data stream having a channel ID which is the same as a user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed, in the another program; and (b) when it is determined that there is the sub-audio data stream having a channel ID which is the same as the user selected channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed in the step (a), selecting the sub-audio data stream having the same channel ID of the another program."**) (Emphasis added). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In support of the rejection of Applicants' base claim 4, the Examiner further cites FIG. 56, FIG. 62, and col. 35 line 25 extending to col. 36 line 59 of Endoh '295 for allegedly disclosing:

"determining if one of the dual mono channels of one of the audio data streams of the

second program corresponds to the one dual mono channel of the one audio data stream of the first program, and reproducing the one dual mono channel of the one audio stream of the second program if the correspondence exists (the previous dual mono channel can be interpret [sic] as the surround sound mode and next program will continue to use the surround sound mode if it is the same, otherwise it will be changed bit stream information BSI."

Again, the Examiner's citation is misplaced. The cited FIG. 56 of Endoh '295 shows the description of an audio coding mode. FIG. 62 illustrates the selection operation of an audio stream and sub-picture stream. The cited col. 35 line 25 extending to col. 36 line 59 of Endoh '295 also refers to the selection of a language code in the video title set menu. There is no disclosure of any "changing [from a first program] to a second program," "determining if one of the dual mono channels of one of the audio data streams of the second program corresponds to the one dual mono channel of the one audio data stream of the first program" and "reproducing the one dual mono channel of the one audio stream of the second program, if the correspondence exists" as defined in Applicants' claim 4.

Likewise, in Applicants' base claim 9, there is no disclosure any where from Hirayama '824 and Endoh '295 of Applicants' claimed "when a first one of the programs is changed to a second one of the programs, searching whether there is a second dual mono channel of the second program having a channel ID which is the same as a channel ID assigned to a first dual mono channel selected by a user of the first program which was being reproduced prior to the change; and selecting the second dual mono channel if the search is successful."

In view of the foregoing reasons, Applicants respectfully request that the rejection of claims 2 and 4-12 be withdrawn.

Lastly, claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hirayama '824, as modified to incorporate selected features from Park (U.S. Patent No. 5,701,384). Since this rejection is predicated upon the correctness of the rejection of Applicants' base claim 1, which Applicants have also demonstrated as being incorrect, Applicants respectfully request that the rejection of claim 3 be withdrawn for the same reasons discussed.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505 ext. 232.

**INTERVIEW:**

In the interest of expediting prosecution of the present application, Applicants respectfully request that an Examiner interview be scheduled and conducted. In accordance with such interview request, Applicants respectfully request that the Examiner, after review of the present Amendment, contact the undersigned local Washington, D.C. attorney at the local Washington, D.C. telephone number (202) 216-9505 ext. 232 for scheduling an Examiner interview, or alternatively, refrain from issuing a further action in the above-identified application as the undersigned attorneys will be telephoning the Examiner shortly after the filing date of this Amendment in order to schedule an Examiner interview. Applicants thank the Examiner in advance for such considerations. In the event that this Amendment, in and of itself, is sufficient to place the application in condition for allowance, no Examiner interview may be necessary.

To the extent necessary, Applicants petition for an extension of time under 37 CFR §1.136. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: \_\_\_\_\_

5/23/06

By: \_\_\_\_\_



Michael D. Stein  
Registration No. 37,240

For

Hung H. Bui  
Registration No. 40,415

1400 Eye St., NW  
Suite 300  
Washington, D.C. 20005  
Telephone: (202) 216-9505  
Facsimile: (202) 216-9510